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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Fresh Mexi-Cali Grill, Inc.

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Serial No. 78187142

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Laurence P. Colton and Nigamnarayan Acharya of Technoprop  
Colton LLC for Fresh Mexi-Cali Grill, Inc.

Ellen Awrich, Trademark Examining Attorney, Law Office 116  
(M. L. Hershkowitz, Managing Attorney).

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Before Seeherman, Hohein and Walters, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Fresh Mexi-Cali Grill, Inc. has appealed from the  
final refusal of the Trademark Examining Attorney to  
register FRESH MEXI-CALI GRILL and design, as shown below,  
and with the words FRESH and GRILL disclaimed, for  
"restaurant and catering services."<sup>1</sup>

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<sup>1</sup> Application Serial No. 78187142, filed November 20, 2002, and  
asserting first use anywhere and first use in commerce on  
September 30, 2002.



Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark MEXICALI GRILL, with GRILL disclaimed, previously registered for "restaurant services,"<sup>2</sup> that it is likely to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have filed briefs. Applicant did not submit a reply brief, nor did it request an oral hearing.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis,

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<sup>2</sup> Registration No. 2359227, issued June 20, 2000.

two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Thus, although applicant has criticized the Examining Attorney for concentrating on these factors, they are certainly critical to the likelihood of determination analysis.

We turn first to the factor of the similarity of the services. The cited registration is for restaurant services, while applicant seeks to register its mark for restaurant and catering services. The services, thus, are identical in part, and otherwise closely related. Applicant itself "acknowledges (as the Examiner points out) that Applicant's and Registrant's services are similar." Brief, p. 7. Because the services are in part identical, they must be deemed to be offered in the same channels of trade to the same classes of consumers. In the case of the identified services, the consumers are the general public. Thus, the du Pont factors of similarity of services and channels of trade favor a finding of likelihood of confusion.

We turn next to a consideration of the marks, noting that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

We must first address applicant's contentions that the cited mark "is highly descriptive of Registrant's services," brief, p. 17; that "the term 'mexicali grill' is descriptive of significant attributes of restaurant services," brief, p. 14; and "consumers may even be looking at 'mexicali grill' as a substitute genus for restaurants that serve food from the mexicali region or of the mexicali style, that is, the Mexico-California border." Brief, p. 15. Applicant's assertions that the registrant's mark is merely descriptive or even generic cannot be considered. The mark is registered, and therefore must be accorded the presumptions of validity accorded by Section 7 of the Trademark Act.<sup>3</sup> As Section 7(b) states:

A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of

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<sup>3</sup> If applicant had wished to attack the registration, the appropriate procedure would have been to file a petition to cancel it.

the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

Moreover, because the cited mark is MEXICALI GRILL, and GRILL has been disclaimed, if we were to treat MEXICALI as descriptive we would, in effect, be treating the entire mark as descriptive, and this would violate the Section 7(b) protections accorded to this registration. Thus, we do not accept applicant's argument that the term MEXICALI in the cited mark should be given little significance in our comparison of the marks.

Applicant is correct that, in determining the issue of likelihood of confusion, marks must be compared in their entireties, although there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). We disagree, however, with applicant's position that the word FRESH, the hyphen in MEXI-CALI and the design element in applicant's marks are the elements that should be accorded greater weight. Although in some cases we have found that the first part of a mark is likely to be impressed on the mind of a purchaser, we do not think

that is the case with the word FRESH in applicant's mark. Because of the special form in which the mark is depicted, the words MEXI-CALI stand out visually as the dominant portion of the mark. Because the words FRESH and GRILL are shown in the same type font, but one that is different from the font for MEXI-CALI, and because these words are descriptive of applicant's services (and have been disclaimed), as the words are depicted in the mark they appear as a single descriptive phrase, FRESH GRILL, advising prospective customers that applicant offers a grill with fresh or made-to-order food.

As for the design element in applicant's mark, as we have frequently stated, if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). In fact, the Court has pointed out that "because restaurants are often recommended by word of mouth and referred to orally, it is the word portion of applicant's mark which is more likely to be impressed on the consumer's memory." In re Dixie Restaurants Inc., supra at 41 USPQ2d 1534, quoting Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983). In this case,

the design element of applicant's mark is an abstract design that appears as a background showcasing the word elements of the mark; thus, it is appropriate to consider the word rather than the design portion of the mark as dominant.

With respect to the hyphen, consumers are not likely to note or remember that applicant's mark has a hyphen, while the registrant's mark does not. The impression of MEXICALI in both marks is the same.

Accordingly, when the marks are compared in their entirety, and giving more weight to the dominant elements, we find that the marks are similar in appearance. They are also highly similar in pronunciation. The only difference is the additional word FRESH in applicant's mark, but since this word merely describes a characteristic of applicant's services, the difference in pronunciation due to this word, just as the difference in appearance, does not serve to distinguish the marks.<sup>4</sup> In terms of connotation, too, the marks are virtually identical.

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<sup>4</sup> Applicant cites *ConAgra, Inc. v. Saavedra*, 4, USPQ2d 1245 (TTAB 1987), as analogous to the present situation. That case involved TAPATIO for hot sauce and PATIO for Mexican style food. However, although applicant has cited the case as part of its argument that the marks are dissimilar in sound, in that case the Board found that there was a similarity in pronunciation of those marks, but that it was outweighed by the differences in connotation. As discussed *infra*, here the connotations of the marks are virtually the same.

Although the additional word FRESH advises that applicant uses fresh ingredients and/or serves made-to-order food, consumers will view this as informational matter which does not change the overall connotation of the words MEXI-CALI GRILL. This situation is very different from those cited by applicant in which the addition of a word to an existing mark can create a mark with a very different connotation. Compare Colgate-Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 167 USPQ 529 (CCPA 1970), in which PEAK PERIOD for personal deodorants was found not to be likely to cause confusion with PEAK for dentifrice. This situation is also different from the cases cited in applicant's response to the first Office action, in which identical marks were found to have different connotations because of the goods on which they were used. Here, of course, the services are identical.

The marks also convey essentially identical commercial impressions. Because of the descriptive significance of FRESH, consumers familiar with the mark MEXICALI GRILL for restaurant services are likely to believe, upon seeing the applied-for mark, that it is a variation of the registrant's mark in which the FRESH characteristic of the services is being touted.



We therefore find that the du Pont factor of the similarity of the marks favors a finding of likelihood of confusion.

In reaching this conclusion, we have considered the strength of the registrant's mark. Although, as we previously stated, we may not accept applicant's characterization of the mark as descriptive, we can consider whether it is suggestive. In that connection, we have reviewed the listing submitted by applicant of a search summary obtained from the USPTO TESS system which lists applications and registrations by their mark and serial number or registration number. We point out that submitting a mere listing of marks and registration/serial numbers is not the proper way to make registrations of record. Rather, copies of the official records themselves, or the electronic equivalent thereof, that is, printouts of the registrations (and not just selected information such as mark and registration number), taken from the USPTO electronic records, must be submitted. See *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, n. 2 (TTAB 1998). However, because applicant submitted this list in response to the first Office action, and the Examining Attorney did not advise applicant of this fact, but, quite

the contrary, discussed the registrations, we have considered the list for whatever probative value it may have.<sup>5</sup> The list, which the Examining Attorney has acknowledged as being marks for restaurant services, consists of seven third-party registrations for marks which include the term MEXICALI, as well as the cited registration. (The third-party applications have no probative value, as they are evidence only of the fact that an application was filed.) Of the seven registrations, we note that four have been cancelled since the time applicant prepared the list. Two registrations, both for JULIO TUMATOES'S MEXICALI BORDER CAFE, are owned by the same entity, and the third is for MEXICALI BLUES RESTAURANT & BAR. Third-party registrations may be used in the same manner as dictionary definitions, that is, to show the meaning of a mark or a portion of a mark. See *Mead Johnson & Company v. Peter Eckes*, 195 USPQ 187 (TTAB 1977). However, we cannot conclude from this limited evidence that MEXICALI has a suggestive meaning that would entitle the registered mark MEXICALI GRILL to a narrow scope of protection. Moreover, even if the scope of protection were limited, it would still extend to prevent the registration

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<sup>5</sup> Accordingly, the Examining Attorney's objection to the third-party registrations, raised in her appeal brief, is denied.

of applicant's highly similar mark FRESH MEXI-CALI GRILL and design for identical services.

Applicant has also argued that the du Pont factor of the number and nature of similar marks in use on similar goods or services favors applicant's position. To that end, applicant has made of record the search summaries retrieved by searches using the Yahoo! and Google search engines. These consist of limited excerpts that appear on a search results page, rather than submissions from the actual websites that are referenced in the excerpt. The Board has previously stated that a search result summary from a search engine, such as Yahoo! or Google, which shows use of a phrase as key words by the search engine, is of limited probative value. See TBMP § 1208.03 and cases cited therein.

We have carefully examined all of the excerpts on the various search results pages submitted by applicant. We note, first of all, that there are many duplicate listings. In fact, applicant appears to have submitted the results of Yahoo! searches of "mexicali grill" and "mexi-cali grill," which searches retrieved the identical "hits." Many of the submissions do not indicate any goods or services, or the listing is so truncated that they have no value in showing use of MEXICALI marks for restaurant services. See, for

example, a heading for "Mexicali-Grill" with only a url, and no further information; and "Girls at MexiCali Grill.jpg" with a reference to a Web Page Creator. Other listings show only that the two words MEXICALI and GRILL appear separately in the excerpt, e.g., "Tacos Mexicali" [heading], "Pontiac Grill"; "A ring of Mexicali Nachos surrounding a bed of rice which is topped with your... of fresh ground sirloin and grill it to perfection..."; "Mexicali Kabobs. INGREDIENTS. 1 pkg ... Prepare barbecue grill." There are even listings in Italian with a url having the IT top level domain, which we infer relates to an establishment in Italy.

This is not to say that there are no references to restaurants using "MEXICALI GRILL" in their names. One restaurant, "Deadhead George's Mexicali Grill," which is described as being in the Florida Keys, appears in several "hits." Another excerpt, headed "Tulsa Dining Guide for Restaurants," lists "Mexicali Border Cafe." There are several excerpts that list "Mexicali Grill," but these may well be references to the registrant. We note that the address listed in registrant's registration is on Santa Cruz Avenue in Los Gatos, California, and several of the excerpts listing a "Mexicali Grill" indicate that it is in California. Moreover, it may well be that all of the

"Mexicali Grill" restaurants listed in the search summaries are the registrant's establishments; certainly there is no way for us to tell from the limited information that applicant has provided that they are not. Even for those excerpts that clearly show third-party usage of MEXICALI marks, we have no way of knowing the extent of the geographic area in which these restaurants operate, or the exposure the marks have had.

In short, we cannot say, based on this record, that "Mexicali Grill" marks have been so widely used that consumers will distinguish among them based on the additional word FRESH, a hyphen, and an abstract background design.

Accordingly, we find that this du Pont factor is neutral.

The next du Pont factor we consider is that of the conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing. Although applicant acknowledges that the ordinary consumers for restaurant services are the general public, rather than, for example, those in a technical field who would have a particular expertise, applicant argues that because consumers encounter so many marks for restaurants during their lifetimes, they "have developed a degree of

sophistication" and "have learned to distinguish even subtle distinctions between marks as applied in the field of restaurant services." Brief, p. 13. Applicant also asserts that "customers of Applicant are knowledgeable consumers and specifically choose Applicant's restaurants," and that customers of registrant are also assumed to be knowledgeable consumers.

We are not persuaded by these arguments. The identification of "restaurant services" encompasses all types of restaurants. Therefore, we must assume that registrant's and applicant's restaurants may be inexpensive restaurants which consumers might impulsively decide to stop in to get a quick bite to eat. In such circumstances, they are not likely to exercise great care in examining the service mark, or engage in an extended analysis of service marks to determine whether marks as similar as applicant's and registrant's identify two different sources of the restaurant services, or are variant marks indicating a single source. As a result, consumers who are familiar with the registrant's MEXICALI GRILL for restaurant services are likely to simply assume, upon seeing FRESH MEXI-CALI GRILL and design for the same services, that it is another mark identifying restaurant services emanating

from the same source. Accordingly, we find that this du Pont factor favors a finding of likelihood of confusion.

The final factors that applicant has addressed are those dealing with evidence of actual confusion. There is no evidence of actual confusion, but we find this of little probative value in this case, since we have not had an opportunity to hear from the registrant; there is no evidence regarding the extent to which either applicant or registrant uses its mark, and thus we are not able to determine whether there has been an opportunity for confusion to occur; and evidence of actual confusion is notoriously difficult to obtain. We therefore deem these factors to be neutral.

Neither the Examining Attorney nor applicant has discussed any other du Pont factors. We note, though, that with respect to the factor as to potential extent for confusion, because restaurant services are offered to all members of the public, the potential for confusion is substantial.

After reviewing the evidence on all the relevant du Pont factors, we find that applicant's use of its applied-for mark in connection with restaurant services is likely to cause confusion with the mark MEXICALI GRILL for restaurant services.

**Ser No. 78187142**

Decision: The refusal of registration is affirmed.